UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,064	11/20/2003	Luca Ferri	FR920030006US1	8678

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IBM CORP. (WIP)
c/o WALDER INTELLECTUAL PROPERTY LAW, P.C.
17330 PRESTON ROAD
SUITE 100B
DALLAS, TX 75252

EXAMINER
TRAN, ELLEN C

ART UNIT	PAPER NUMBER
2134	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 June 2008*.
2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-8* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to: amendment filed on 11 February 2008 with an original

application filed on 20 November 2003 with acknowledgement of the benefit of a foreign

application filed 10 March 2003.

2.   Claims 1-8 are pending; claims 1 and 8 are independent claims. The Objection to the

Specification is removed due to amendment.

Response to Arguments

3.   Applicant's arguments filed 11 February 2008 have been fully considered however they

are not persuasive.

I)   In response to Applicant's argument on page 5, *"The Office Action rejects claims 1-8*

under 35 U.S.C. § 112, second paragraph, as being indefinite".

The Examiner has withdrawn the *112* rejection but notes using the broadest reasonable

interpretation (since no further clarification is offered by Applicant), the entity is interpreted to

be equivalent to the client system. Applicant is reminded although the claims are interpreted in

light of the specification limitations from the specification are not placed into the claims.

II)   In response to Applicant's argument beginning on page 10, *"Nowhere in this section, or*

in any other section of Bhagavatula, is there a teaching of a client system transmitting a request

of authentication of the product to a server system".

The Examiner disagrees with argument. Bhagavatulat teaches requesting authentication

of a product in col. 8, lines 20-25. Note the 'product' is interpreted equivalent to 'data requested

by the user'. Applicant is also reminded although an attempt is made to cite the column and line

numbers the entire reference must be considered. As for a 'server system' col. 8, line 27 teaches

a server system.

III)   In response to Applicant's argument beginning on page 11, *"Bhagavatula fails to teach*

certifying that the product originates from the entity using sensitive information of the entity

stored on the server system".

The Examiner disagrees with argument. Bhagavatula teaches the above limitation in

col. 7, line 57 through col. 8, line 25. Note the sensitive information is equivalent to user name

or ID, a secret password, a dynamically changing password, a PIN, answers to security

questions, biometric data, etc.... which are taught in the Bhagavatula reference.

IV)   In response to Applicant's argument beginning on page 12, *"Bhagavatula fails to teach*

returning a representation of the certification to the client system".

The Examiner disagrees with argument. Bhagavatula teaches the above limitation in

col. 8, lines 54-67. Note the 'representation of the certification' is interpreted equivalent to the

data selection page which is returned to the user.

V)   In response to Applicant's argument beginning on page 13, *"Claims 4-7 are dependent*

on independent claim 1 and, thus, these claims distinguish over Bhagavatula for ... Moreover,

Graves does not provide for the deficiencies of Bhag

The Examiner disagrees with argument. There are no deficiencies in Bhag.

VI)   In response to Applicant's argument beginning on page 14, *"The Office Action alleges*

that Graves teaches where the step of certifying that the product originates from an entity using

sensitive information of the entity stored on the server system includes automatically retrieving a

private key of the entity stored on the server system".

The Examiner disagrees with argument. Grave teaches the above limitation on pages 5-6, paragraphs 0050, 0052-0053 and 0058. Note in paragraph 0050, Graves teaches that the keys are stored on a separate server. Graves teaches that the PTA and authentication services can be integrated [0050] in addition the browser retrieves the appropriate key. As well as in paragraph 0059 that an automatically triggered client script can be used to eliminate the need to click through the intermediate pages. Applicant is also reminded although an attempt is made to cite the column and line numbers the entire reference must be considered.

VII)   In response to Applicant's argument on page 16, *"Bhagavatula and Graves, taken alone or in combination, do not teach or suggest the client system invoking a remote command on the server system"*

The Examiner disagrees with argument. Grave teaches the above limitation on page 6, paragraph 0053. Note the remote command is interpreted equivalent to private key and digital signature now available by selecting the account.

VIII)   In response to Applicant's argument beginning on page 16, *'Bhagavatula and Graves, taken alone or in combination, do not teach ... as argued with respect to claim 1 ... Applicants respectfully submit that one of ordinary skill in the art would not confuse Grave's generation of authentication challenge for a buyer to that authenticates whether a user is authorized to the payment instrument with the presently claimed generating a digital signature of the product that certifies that the product originates from an entity"*

The Examiner disagrees with argument for multiple reasons. First, Bhagavatula teaches the limitations as argued with respect to claim 1 as shown above. Second, as shown in the Office Action Graves teach the limitation of generating a digital signature as stated in paragraph 0050,

0052, and 0053. As known and repeated by Applicant Grave's invention is utilized to

authenticate a user for a payment instrument.   This teaching does not take away the teachings of

Graves automatically generating a digital signature by selection of account also see paragraph

0059.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

> (e) the invention was described in (1) an application for patent, published under section
> 122(b), by another filed in the United States before the invention by the applicant for
> patent or (2) a patent granted on an application for patent by another filed in the United
> States before the invention by the applicant for patent, except that an international
> application filed under the treaty defined in section 351(a) shall have the effects for
> purposes of this subsection of an application filed in the United States only if the
> international application designated the United States and was published under Article
> 21(2) of such treaty in the English language.

5.   **Claims 1-3,** are rejected under 35 U.S.C. 102(e) as being anticipated by Bhagavatula et

al. U.S. Patent No. 7,140,036 (hereinafter '036).

       As to independent claim 1, "A method of authenticating a digitally encoded product

being originated by an entity having at least one authorized subject, the method including

the steps of: a client system transmitting a request of authentication of the product to a

server system" is taught in '036 col. 8, lines 20-25;

       "and returning a representation of the certification to the client system" is shown in

'036 col. 8, lines 54-67;

"**the server system verifying whether the request is received from an authorized subject, and responsive to a positive verification: certifying that the product originates from the entity using sensitive information of the entity stored on the server system**" is disclosed in '036 col. 7, line 57 through col. 8, line 25.

As to dependent claim 2, "**wherein the step of verifying whether the request is received from an authorized subject includes: comparing an address of the client system with an indication of authorized addresses stored on the server system**" is taught in '036 col. 5, lines 5-14.

As to dependent claim 3, "**wherein the step of verifying whether the request is received from an authorized subject includes: comparing an identifier of a user logged on the client system with an indication of authorized users stored on the server system**" is shown in '036 col. 8, lines 2-10.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7.   **Claims 4-8,** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bhagavatula et al. U.S. Patent No. 7,140,036 (hereinafter '036) in view of Graves et al. U.S. Patent Application Publication No. 2004/0177047 (hereinafter '047).

As to dependent claim 4, the following is not taught in '036: **"wherein the step of certifying includes: automatically retrieving a private key of the entity stored on the server system, and digitally signing the product using the private key"** however '047 teaches that the PTA and private keys may be hosted in a number of locations such as a separate server, and that the authentication process is carried out without human participation (i.e. automatically), and furthermore that the private key is used to create the digital signature on pages 5-6, paragraphs 0050 and 0052-0053.

It would have been obvious to one of ordinary skill in the art at the time of the invention of a centralized identity authentication for electronic communication network taught in '036 to include a means to utilize private keys for authentication. One of ordinary skill in the art would have been motivated to perform such a modification because there is a need for buyer authentication in online purchases see '047 (page 2, paragraph 011) "Thus, there is a need for substantial buyer authentication in online commerce transactions. There is further a need for an approach to buyer authentication which is also flexible enough to easily adapt to varying levels of security for different applications and also to the adoption of new technologies. The approach preferably also does not impose significant burdens on or require extensive modification of the existing transaction processing infrastructure".

As to dependent claim 5, "wherein the step of automatically retrieving the private key includes: calling a signing command passing a password for accessing the private key as a parameter" is taught in '047 page 6, paragraph 0053.

As to dependent claim 6, "wherein the step of automatically retrieving the private key includes: calling a signing command with an option causing the import of the private

key from a private configuration memory area of the server system" is shown in '047 pages 5-6, paragraphs 0050 and 0052-0053.

As to dependent claim 7, **"further including the steps of: the client system invoking a remote command on the server system, the server system verifying whether the remote command is included in a predefined list stored on the server system, the list including at least one remote command for satisfying the request of authentication, and the server system executing the remote command if included in the list"** is disclosed in '047 pages 5-6, paragraphs 0050 and 0052-0053.

As to independent claim 8, **"A method of authenticating a software product being originated by an entity having at least one authorized subject, the method including the steps of: a client system transmitting a request of authentication of the product to a server system"** is taught in '036 col. 8, line 20-31;

"the server system verifying whether the request is received from an authorized subject, and responsive to a positive verification:" is disclosed in '036 col. 7, line 57 through col. 8, line 25;
the following is not taught in '036:

"generating a digital signature of the product using a private key of the entity stored on the server system" however '047 teaches that the PTA and private keys may be hosted in a number of locations such as a separate server, and that the authentication process is carried out without human participation (i.e. automatically), and furthermore that the private key is used to create the digital signature on pages 5-6, paragraphs 0050 and 0052-0053;

"and returning the digital signature to the client system, wherein the digital

signature certifies that the product originates from the entity" however '47 teaches that a

digital record of the transaction can by shown with the digital signatures on page 6, paragraph

0056.

It would have been obvious to one of ordinary skill in the art at the time of the invention

of a centralized identity authentication for electronic communication network taught in '036 to

include a means to utilize private keys for authentication. One of ordinary skill in the art would

have been motivated to perform such a modification because there is a need for buyer

authentication in online purchases see '047 (page 2, paragraph 011) "Thus, there is a need for

substantial buyer authentication in online commerce transactions. There is further a need for an

approach to buyer authentication which is also flexible enough to easily adapt to varying levels

of security for different applications and also to the adoption of new technologies. The approach

preferably also does not impose significant burdens on or require extensive modification of the

existing transaction processing infrastructure".

Conclusion

THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the

extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

8.   It is noted, PATENTS ARE RELEVANT AS PRIOR ART FOR ALL THEY CONTAIN

"The use of patents as references is not limited to what the patentees describe as their own

inventions or to the problems with which they are concerned. They are part of the literature of

the art, relevant for all they contain." In re Heck, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039

(Fed. Cir. 1983) (quoting In re Lemelson, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA

1968)). A reference may be relied upon for all that it would have reasonably suggested to one

having ordinary skill the art, including nonpreferred embodiments (see MPEP 2123).

9.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Ellen C Tran whose telephone number is

 (571) 272-3842. The examiner can normally be reached from 7:30 am to 4:00 pm. If attempts

to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand

can be reached on (571) 272-3811. The fax phone number for the organization where this

application or proceeding is assigned is (571) 273-8300.

        Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/ELLEN TRAN/
Primary Examiner, Art Unit 2134
7 September 2008